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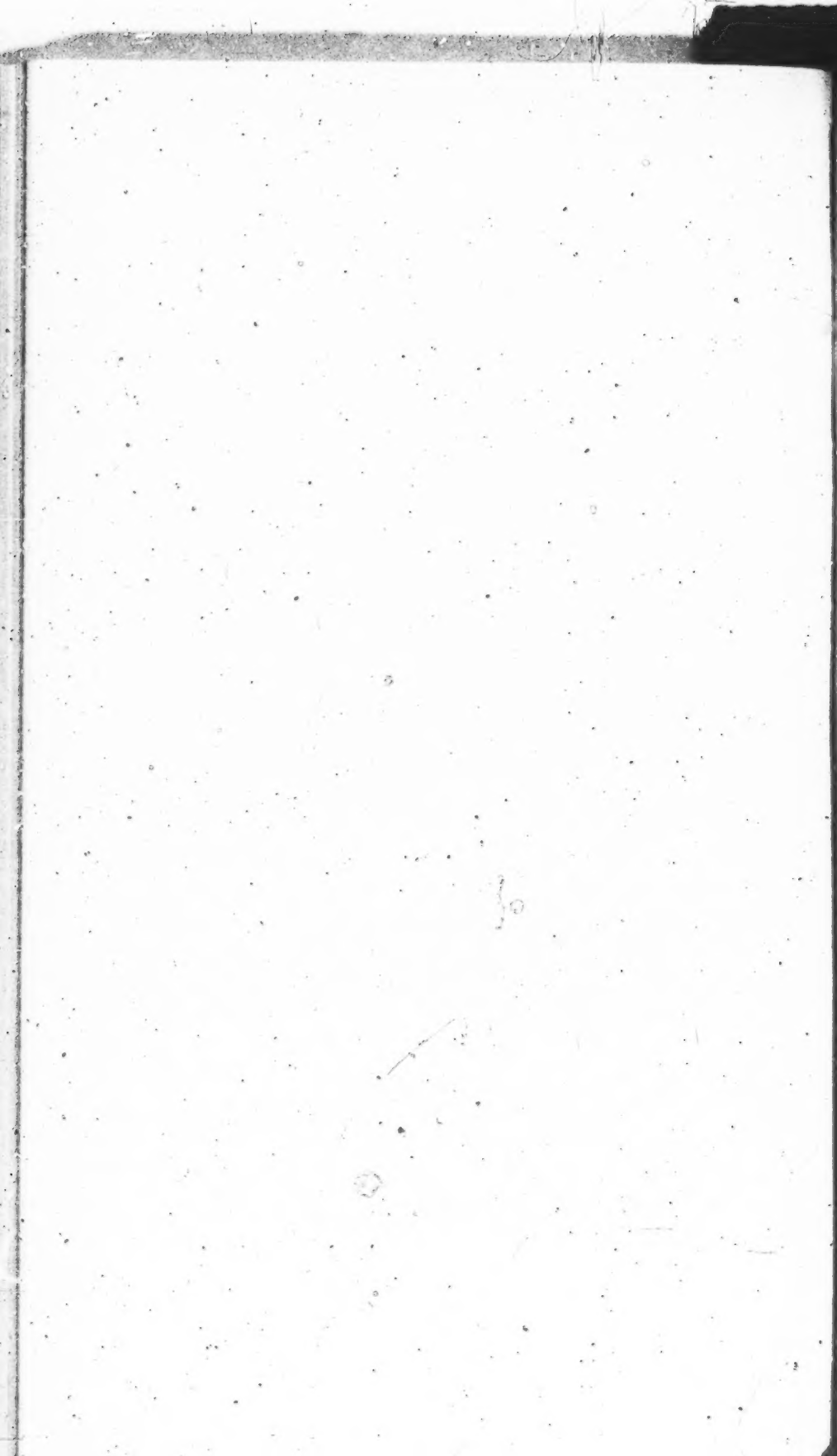
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IN THE
Supreme Court of the United States

October Term, 1938

No. 582

**ELECTRICAL FITTINGS CORPORATION, JOSELSON
SALES CORPORATION, SAMUEL JOSELSON AND
BELLE JOSELSON**

Petitioners

v.

**THE THOMAS & BETTS CO. AND NATIONAL
ELECTRIC PRODUCTS CORPORATION**

Respondents

**BRIEF OF THE THOMAS & BETTS CO. AND
NATIONAL ELECTRIC PRODUCTS CORPORATION
IN OPPOSITION TO PETITION, ENTITLED
AS ABOVE, FOR WRIT OF CERTIORARI**

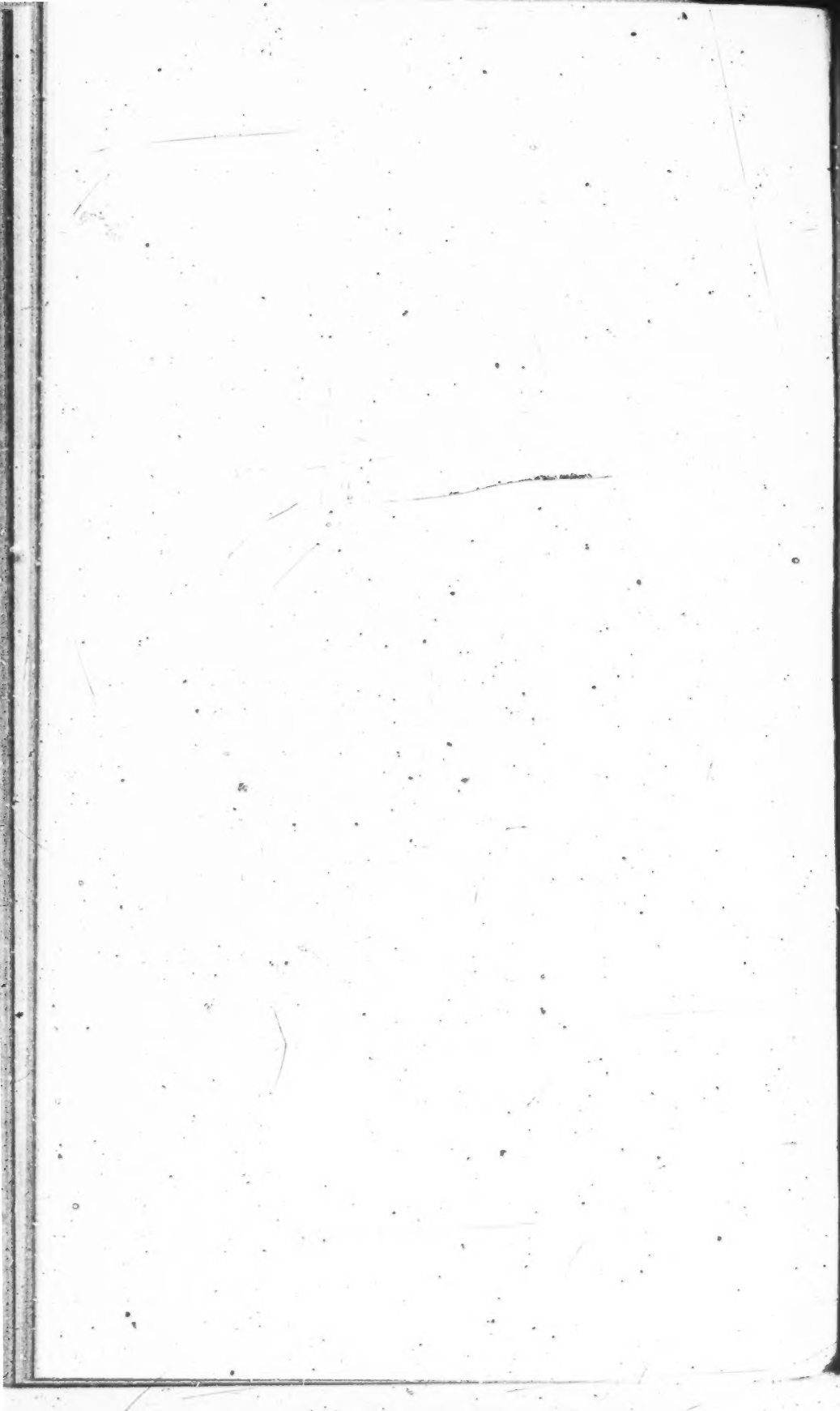
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ELECTRICAL FITTINGS CORPORATION, JOSEL-
SON SALES CORPORATION, SAMUEL JOSEL-
SON and BELLE JOSELSON,

Petitioners,

v.

THE THOMAS & BETTS CO. and NATIONAL
ELECTRIC PRODUCTS CORPORATION,

Respondents.

Brief of the Thomas & Betts Co. and National Electric Products Corporation in Opposition to Petition, Entitled as Above, for Writ of Certiorari

*To the Honorable, The Chief Justice and Associate
Justices of the Supreme Court of the United States:*

This is an ordinary patent suit involving no questions of law or public importance, no conflict of opinions, and no other questions, such as are indicated in Rule 38, subdivisions 3a, 3b and 3c, of this Court.

The decision of the Court below, dismissing petitioners' (defendants') appeal, is reported at 39 U. S. Pat. Q. 509, and at R. 312. The decision of the District Court is reported at 23 Fed. Supp. 920 and at R. 259. See R. 276 for the decree of the District Court. The decision of the District Court with respect to the filing by respondents of

the disclaimer as to Claim 2 of the patent in suit has not been reported but will be found in the record (p. 306).

If the single question, as presented in the Petition and by petitioners' (defendants') brief, were not so seriously complicated and confused by erroneous and extravagant statements of law and facts, other than those necessary for its determination, including arguments based upon matters which the District Court specifically found were not supported by the record, respondents would be reluctant to file a brief in opposition thereto of the character here presented, if any.

It is to be noted that the statement by petitioners of the question presented is subtly misleading and stated so broadly it appears to have been calculated to convey the impression that the question here presented is the same as that presented in *Oliver-Sherwood Co. v. Patterson Ballagh Corp.*, 95 F. (2d) 71 and *Monarch Marking System Co. v. Dennison*, 92 F. (2d) 90 (C. C. A. 6).

Respondents Re-state Question Presented by Petitioners

Based upon the record facts of this case the question presented should be re-stated as follows:

The sole question for decision of this Court, in the event a writ of certiorari is granted, is whether or not, in an *ordinary* patent infringement suit in which the defendants sought no affirmative relief and in which, after a hearing upon the merits, a final decree is entered dismissing plaintiffs' bill of complaint (a) *as to contributory infringement*, (b) *for an injunction*, and (c) *for an accounting*, and in which plaintiffs did not appeal from said dismissal on any grounds, the defendants have a right of ap-

peal from a *finding* of the District Court on an issue specifically raised for determination by defendants' answer to the Bill.

It does not appear in the sole question presented by petitioners that *their answer to the bill sought no affirmative relief* and that *respondents did not appeal on any ground from the final decree dismissing the bill of complaint*. Nor do petitioners state, as does the Court of Appeals in its decision below, R. 313, "*that the defendants have already received all the relief they can obtain in this action* * * *". Accordingly, respondents submit that the question presented by petitioners is inaccurate and misleading.

It may not be amiss to point out the usual issues in a patent infringement suit are validity and infringement and that they are terminated in one of the following ways: (1) claim sued upon held valid and infringed; (2) claim sued upon held valid but not infringed; (3) claim sued upon held not infringed, and (4) claim sued upon held invalid. Where the claim sued upon has been held valid and infringed plaintiff is entitled to an accounting, and if an accounting is desired an interlocutory decree is entered. In all other cases a final decree is entered dismissing the bill.

As the Decree of the District Court Terminated the Case in Petitioners' (Defendants') Favor by Denying Respondents' (Plaintiffs') Prayer for an Injunction and an Accounting, the Court Below Did Not Have Jurisdiction

The bill of complaint in this case was dismissed by the District Court (R. 276). Respondents (plaintiffs below) did not appeal from the final decree of dismissal. Peti-

tioners (defendants below) admittedly claim no title to the patent in suit and no right to an injunction based thereon. Hence, the lower Court was without equitable jurisdiction to hear and determine the question even as presented. *Peters Patent Corp v. Bates & Klink, Inc.*, 295 U. S. 392, 394; 79 L. Ed. 1498, 1500.

**Petitioners Are Seeking to Have This Court Consider
"A Moot or Academic Question of Law" or Judicially
Determine "A Moot Case"**

Respondents, plaintiffs below, respectfully submit that this petition must be denied also upon the ground that the bill of complaint having been dismissed by final decree of the District Court, *from which decree respondents did not appeal*, thus denying respondents' prayer for an injunction and an accounting, the obvious result is that all equitable jurisdiction of the Court below has been ousted and petitioners have therefore raised, based on the record below, only a *moot or academic question* of law or a *moot case* with which this Court is not concerned, and cannot be required to answer. This Court, in the case of *Triplett v. Lowell*, 297 U. S. 638, 649, 80 L. Ed. 949, 956, said:

"We are not required to answer academic questions, or questions which may not arise in the pending controversy. See White v. Johnson, supra (282 U. S. 373, 75 L. Ed. 394, 51 S. Ct. 115); United States v. Hall, 131 U. S. 50, 33 L. Ed. 97, 9 S. Ct. 663, supra; Webster v. Cooper, 10 How. 54, 55, 13 L. Ed. 325, 326." (Emphasis ours.)

The judicial power does not extend to the determination of abstract questions; and claims based merely upon "assumed potential invasions" of rights are not enough to

warrant judicial intervention. See, *Ashwander v. Tennessee Valley Authority*, 297 U. S. 288, 324, 80 L. Ed. 688, 698-9.

We know of no case where an appeal to this Court or to the Circuit Court of Appeals of any circuit has ever been allowed to a defendant from the dismissal of a bill of complaint upon its merits, where the appeal merely presented a moot question of law or a moot case. Cf. Sections 2906, 2958, 2969 and 2978, *Cyclopedia of Federal Procedure*.

Defendants are not under injunction. Compare the following: *Gamewell Fire-Alarm Tel. Co. et al. v. Municipal Signal Co. et al.*, 61 Fed. 208 (C. C. A. 1); *Lockwood et al. v. Wickes, et al.*, 75 Fed. 118 (C. C. A. 8); and *Chapin v. Freidberger-Aaron Manufacturing Co.*, 158 Fed. 408 (C. C. A. 3).

Where, as here, petitioners sought to dismiss respondents' bill of complaint on two counts, namely, (1) invalidity of the patent in suit, and (2) non-infringement, and have prevailed, albeit the Court's opinion is based upon only one of said grounds, namely, non-infringement, *petitioners have obtained full relief against the respondents* and are not entitled to urge, on appeal, or in a petition to this Court for a writ of certiorari, that the decree in this case should have been based on both grounds, and thus obtain a review of a finding of validity as to one of the claims of the patent in suit. *P. E. Sharpless Co. v. William A. Lawrence & Son* (C. C. A. 3), 208 Fed. 886; *New York Telephone Company v. Maltbie*, 291 U. S. 645, 78 L. Ed. 1041, 54 S. Ct. 448; *Lindheimer v. Illinois Bell Telephone Co.*, 292 U. S. 151, 78 L. Ed. 1182, 1197.

Comment or Correction Concerning the Sole Question Presented and Some of the Statements in the Petition and Brief Filed in Support Thereof

Counsel for the petitioners in this case was also counsel for the petitioner in the case of *General Talking Pictures Corporation v. Western Electric Co. Inc., et al.*, 304 U. S. 175, referred to on page 9 of petitioners' brief. In stating the sole question now presented, petitioners have ignored the "controlling facts" in this case just as did the petitioner presenting the questions certified to this Court for ruling in *General Talking Pictures Corp. v. Western Electric Company, Inc., et al.*, 304 U. S. 175. Rehearing granted May 31, 1938, see 304 U. S. 587. Reaffirmed November 21, 1938, 305 U. S., 83 L. Ed. 110. Petition for rehearing denied January 3, 1939, 83 L. Ed. 320.

Decision of the Court Below States the Law

The Court below, at the bottom of the page (R. 313), states the law applicable to this question as respondents understand it to be, as follows:

"A party may not appeal from a decree, which terminated in his favor the entire cause of action sued on, *merely to obtain a review of findings*, which he believes erroneous, but which are unnecessary to support the decree. *Lindheimer v. Illinois Bell Telephone Co.*, 292 U. S. 151, 176; *N. Y. Telephone Co. v. Maltbie*, 291 U. S. 645." (Emphasis ours.)

Petitioners' Question is Not Based Upon a Conflict of Decisions

There is no conflict between the decision of the Court below (R. 312) and the decision of the Circuit Court of Appeals in the Ninth Circuit and the practice of the Cir-

enit Court of Appeals in the Sixth Circuit, as stated on page 7, paragraph 2, of the petition. The Ninth Circuit case relied upon by petitioners is that of *Oliver Sherwood Co. v. Patterson-Ballagh Corporation*, 95 F. (2d) 71, C. C. A. 9. In that case, unlike the case at bar, *the plaintiff appealed from the decree of non-infringement*. In *Monarch Marking System Co. v. Dennison*, 92 F. (2d) 90, C. C. A. 6, covering what the petitioners describe as "the practice" in the Sixth Circuit, *both plaintiff and defendant appealed from the decree*.

Barber Asphalt Case, 302 U. S. 458, 82 L. Ed. 371

Petitioners state at page 16, that respondents are utilizing the patent in a manner and for a purpose which this Court condemned in the *Barber Asphalt* case, 302 U. S. 458, 82 L. Ed. 371. This is not true. The District Court in this case found (R. 268, fol. 802) that "the plaintiffs' connectors are not, in my opinion, standard articles of commerce". The decision of this Court in the *Barber Asphalt* case, *supra*, reads in part as follows:

"The following facts were proved or admitted.

"The Barber Company and Leitch Manufacturing Company are competing manufacturers of *bituminous emulsion*—an unpatented *staple article of commerce* produced in the United States by many concerns *and in common use by their customers for many purposes*." (Emphasis ours.)

Notwithstanding petitioners' extravagant statement concerning the relevancy to the instant case of the holding of this Court in the *Barber Asphalt* case, the foregoing shows that the controlling facts before the Court in the *Barber* case are not present in the case at bar.

No Question of Price Control Involved in This Case

All matters presented and discussed in paragraphs 6, 7, 8 and 9 of page 3 of the petition with respect to respondents' price control, etc., were presented to the District Court and with respect thereto the following findings were made in its decision (R. 268, fols. 803, 804):

1. "There is *no proof* in this case that any effort has been made to effect price control."
2. "Plaintiffs' connectors *are not*, in my opinion, *standard articles of commerce*."
3. "There is *no evidence* in this case that commercial success was due to any unusual promotional efforts." (Emphasis ours.)

Note also the admission (R. 289) of counsel for petitioners at the argument before the District Court on defendants' petition for rehearing, as follows:

"Mr. Crews: I offered the answers to the interrogatories and *I haven't raised any question as to the legality of price-fixing*.

"The Court: I realize that. That is my reason for the interruption of Mr. Fassett's reading of those citations. *The question of the legality of price-fixing is not the question. At any rate it was not argued before me.*" (Emphasis ours.)

Petitioners Paint With a Wide Brush

Respondents confidently believe that one cannot read the petition and consider the record in this case without having it clearly appear that petitioners have painted their case with a wide brush. Accordingly, respondents' position

is that (1) if petitioners, as stated at page 16 of brief, honestly believe that "*the patent on its face is invalid*" and (2) if petitioners, as stated on page 17, honestly believe that "*the patent in its entirety*" is invalid because of respondents' unreasonable delay in filing a disclaimer of claim 2 which was held to be invalid by the District Court, and (3) if petitioners, as stated on pages 6 and 11, are correct that petitioners "*will again be sued*" or that further litigation "*is threatened*", under the patent in suit, it would seem that petitioners should have no hesitancy in conducting themselves accordingly. Petitioners certainly know that under the law of laches respondents are under the duty to protect their patent rights and that necessarily in the natural course of things petitioners will have an opportunity to raise, at the proper time and place, any matter of a justiciable character.

In Conclusion

In view of all of the foregoing, respondents submit that as a matter of law based upon the record facts, the petition herein for a writ of certiorari to the Circuit Court of Appeals for the Second Circuit should be denied.

Respectfully submitted,

BOHLEBER & LEDBETTER,
Attorneys for Respondents.

WILLIAM BOHLEBER,
FRANCIS H. FASSETT,
Of Counsel.

New York, N. Y., January 27th, 1939.